

REMARKS

The Examiner is thanked for the interview so courteously held on May 3, 2004. Pursuant to that interview, Claims 1 and 5-6 have been amended to more definitely set forth the invention and obviate the rejections. In addition, new claims 7-9 have been presented. Support for new claims 7-9 can be found in the Specification in Table 1(3) on page 61. The present amendment is believed not to introduce new matter. Claims 1-9 are now in the application.

Reconsideration is respectfully requested of the rejection of Claims 1-4 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to the expression in Claims 1, 5 and 6 of “having a regular reflection percentage of 1% or less in an amount of 1 – 100 wt%” and the phrase “at least one of a regular reflection percentage and a diffuse reflection percentage of which is more than 5%, and an amount of less than 10 wt%”, it is respectfully submitted that there is ample disclosure in the original Specification on page 50, last paragraph, for this expression in the claims. As described in the present specification, powder is classified into (i) powder with minimized regular reflection and diffuse reflection, or reflection-minimized powder, ii) semi-reflection-minimized powder, and iii) reflection powder.

In particular, as discussed with Examiner Wells during the interview, the reflection-minimized powder is described on page 50, lines 18, to page 51, line 6, as a powder wherein the “**regular reflection** of the powder is suppressed to 1% or less with respect to the regular reflection of a quartz plate”, and wherein the “diffuse reflection of the powder is suppressed to 1% or less with

respect to the diffuse reflection of a standard white plate [formed from barium sulfate ( $\text{BaSO}_4$ )]". This was further described in original claim 3. The examples of the reflection-minimized powder are described in Table 1(1) on page 59. It is believed, in view of the Examiner's statements during the interview and the above recitations of support, that this disclosure provides adequate support for the term "regular reflection".

Further, with regards to the claimed weight percentage of 10 wt.% or less of a second powder, it is believed that support for this claimed weight range is provided on page 52, fourth paragraph, and more specifically on page 53, lines 15-24.

With respect to the recitation of a diffuse reflection percentage of more than 5%, if the reflection powder is defined by using the terms "a regular reflection percentage" and "a diffuse reflection percentage", the reflection powder is powder wherein at least one of a regular reflection percentage and a diffuse reflection percentage is more than 5%. The examples of the reflection powder are described in Table 1(3) on page 61. Specifically, calcium phosphate, cellulose, titanium oxide (rutile-type), sericite and barium sulfate are all shown to have diffuse reflection percentages of greater than 5%, and mica, titanium oxide (rutile-type), titanium oxide (micropowder) and zinc oxide have regular reflection percentages of greater than 5%. To more definitely define the invention, new claims 7-9 have been introduced herein to claim said compositions.

Furthermore, in order to clearly explain the present invention, the undersigned's are attaching hereto an Appendix A, illustrating the relationship of a regular reflection percentage and a diffuse reflection percentage, and, the reflection-minimized powder, the semi-reflection-minimized powder and the reflection powder. It can be seen therein that a reflection-minimized powder and a semi-

reflection minimized powder occur in the overlapping area illustrated in the “Relationship of reflection percentage and powder” section of Appendix A.

As previously stated in the Amendment filed September 12, 2003, the second layer finishing composition contains powder with minimized regular reflection and diffuse reflection (reflection-minimized powder, or a first powder) in an amount of 1-100 wt.% and may contain reflection powder (a second powder) in an amount of less than 10 wt.%. It is maintained that the reflection-minimized powder is described in detail in the Specification on page 44, lines 20-27, and on page 50, line 18, to page 51, line 6. In order to avoid using the term “minimized”, the reflection-minimized powder is defined as a first powder by using regular reflection percentage and diffuse reflection percentage in claim 1. The amount of the reflection-minimized powder in the second layer finishing composition is described in the Specification on page 52, lines 15-21. The examples of the reflection-minimized powder are mentioned in Table 1 (1).

The reflection powder is described in the Specification on page 52, lines 2-10. The reflection powder is also defined as a second powder by using regular reflection percentage and diffuse reflection percentage in claim 1. The amount of the reflection powder in the second layer finishing composition is described in the Specification on page 52, lines 15-24. The examples of the reflection powder are mentioned in Table 1 (3). In addition, please see on page 53, line 11, to page 54, line 10.

Therefore, as discussed with Examiner Wells during the interview herein, it is respectfully submitted that all of the terms referred to by the Examiner in Claims 1-6 are described in the Specification as originally filed. It is further respectfully submitted that one of ordinary skill in the art would understand the Specification to disclose the subject matter in the terms used in the claims.

Therefore, it is respectfully submitted that the Examiner would be justified in no longer maintaining this rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1-6 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Firstly, the Examiner has stated that the phrase “a second powder, at least one of a regular reflection percentage and a diffuse reflection percentage of which is more than 5%, in an amount of less than 10 wt.%, on the basis of the entirety of the finishing composition” in claim 1 (part ii), claim 5 (part ii), and claim 6 (part ii), is vague and indefinite. Claims 1, 5 and 6 have been amended herein to now more clearly state that the second layer finishing composition contains 10 wt.% or less, based on the entirety of the second layer finishing composition, of a second powder, wherein the second powder has a regular reflection percentage and/or a diffuse reflection percentage thereof is more than 5%. It is believed, in view of the discussions held with Examiner Wells during the interview, that such amendment clarifies said claims, in that it is now understood that the recited weight percent refers to the amount of the second powder in the second layer finishing composition.

Secondly, the Examiner indicates that the term “low” in Claim 6 is a relative term and indefinite. As discussed with the Examiner, claim 6 has been amended so as to delete the term “low viscosity” in the claim. Further, claim 5 has been amended to correct the spelling of the term “powder”. It is believed that these amendments render the rejections thereon moot.

It is now believed, in view of the amendment of the claims herein, that the claims now in the case are definite as required by the second paragraph of 35 U.S.C. § 112. Consequently, it is believed that the Examiner would be justified in no longer maintaining the rejection. Withdrawal of

the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over JP 6-128122 ('122) in view of JP 9-194323 ('323).

The cited JP '122 reference is directed to makeup compositions comprising a first layer foundation composition and second layer foundation finishing composition. However, as the Examiner has correctly recognized on page 5, lines 1-3, of the instant Office Action, the cited JP '122 reference fails to teach a first layer foundation composition containing a polyether modified as silicone, water and a hydrophobic powder in addition to the silicone oil. Furthermore, the cited '122 reference fails to disclose or suggest that limiting a finishing layer containing a reduced amount of reflection powder (referred to as the "second powder" in B.ii of claims 1, 5 and 6), such as titanium oxide and mica, to no more than 10 wt% of the finishing layer (as claimed in claims 1, 5 and 6), provides a natural appearance to the skin while simultaneously allowing the first layer of the multilayer composition to conceal irregularities in the skin. Rather, this teaching comes only from the present invention, and constitutes an important element or aspect thereof.

The cited secondary JP '323 reference teaches a cosmetic composition containing a silicone oil, a polyether-modified silicone of the formula instantly claimed, water and hydrophobic powder, but fails to teach a second layer finishing composition containing 1-100 wt.% of the reflection minimized powder and less than 10 wt.% of the reflection powder, as claimed herein in claims 1 and 5-6, the combination of which allows a user to achieve the object of the present invention.

Importantly, as mentioned above, the reflection powder incorporated into the second layer of finishing composition is in an amount of less than 10.0 wt.%, as now claimed herein in amended

claims 1, 5 and 6. If the reflection powder is contained in an amount of 10.0 wt.% or more on the basis of the entirety of the finishing composition, a powdery or white appearance attributable to the reflection powder occurs, thus defeating one of the objectives of the present invention, i.e., to impart a natural appearance to human skin while simultaneously concealing blemishes thereon (see Specification, page 53).

Proof of an unexpected improvement can rebut a prima facie case of obviousness. In re Murch, 464 F2d 1051, 175 USPQ 89 (CCPA, 1972). In re Costello, 480 F2d 894, 178 USPQ 290 (CCPA, 1973). The chemical compound and its properties are inseparable. A formula is not the compound nor what is patented. Patentability does not, therefore, depend solely on the similarity of the formula of the claimed compound or that of a prior art compound. The unobviousness of its properties must also be considered. In re Papesch, 315 F2d 381, 137 USPQ 43 (CCPA, 1963); In re Ward, 329 F2d 1021, 141 USPQ 227 (CCPA, 1964); In re Stemniski, 444 F2d 581, 170 USPQ 343 (CCPA, 1971).

In conventional multilayer cosmetic compositions, a first layer and a second layer composition are present, wherein the first layer composition generally acts merely to adhere the second layer of the composition onto the skin, but does not conceal skin pores. In contrast, in the present invention, an *unexpected improvement* was discovered in that, while the first layer foundation composition of the multilayer cosmetic composition is able to provide a smooth appearance and correct/conceal blemishes and skin pores, the second layer finishing composition allows application of a thin coating of the first layer foundation composition to the skin to be sufficient for concealment of blemishes and skin pores while, in addition, simultaneously imparting a

natural appearance.

"Synergism" is a very broad term and means "combined action of two or more agents... that is greater than some of the action of one of the agents used alone...". In re Luvisi, et al., 342 F2d 102, 144 USPQ 646 (CCPA, 1965). The evidence should at least demonstrate an effect greater than the sum of the several effects taken separately. Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F2d 804, 10 PQ 2d 1843 (CAFC, 1989). There are undoubtedly many appropriate tests for determining synergism. In each case the facts must be analyzed to determine whether the chosen method as in fact clearly and convincingly demonstrated an unobvious result. Ex parte Quandranti, 26 PQ 2d 1071 (BPAI, 1992).

The present invention provides a cosmetic kit that enables application of a multilayer cosmetic composition onto the skin of a user, wherein the first layer foundation conceals skin blemishes and hides skin pores, while the second finishing layer foundation allows a natural appearance to be realized while still covering said blemishes. It was unexpectedly discovered that a synergistic effect is obtained by the application of the combination of the first layer foundation and the second layer finishing composition onto the skin of a user, an effect magnified greatly over the effect achieved when using the components alone/separately. To demonstrate these unexpectedly improved and synergistic results using the multilayer cosmetic composition of the present invention, the present inventors conducted a series of comparative tests using twenty panelists, as outlined on page 61 of the Specification. The results of these tests may be found in Tables 2, 4 and 5 on pages 64, 66 and 69 of the Specification.

In particular, the comparative tests shown in Table 2 demonstrate the synergistic

effectiveness of the compositions of the present invention as now claimed in concealing irregularities of the skin while imparting a natural appearance to the skin. The test results shown in Table 4 of the tests comparing the comparative examples 1-3 to the compositions of the present invention (identified as P EX.1-6) clearly demonstrate that the compositions of the present invention provide much improved natural appearance over the compositions of the prior art. However, as shown in Table 4, when using a conventional cosmetic foundation composition with the second layer finishing composition of the present invention applied thereon, concealment of irregularities in the skin is not achievable.

Further, it is believed that Table 5 clearly compares the present invention with the disclosure of the closest prior art. In particular, JP '122 describes a second layer makeup finishing composition containing diffuse reflection powder. The diffuse reflection powder includes nylon powder, methyl methacrylate powder, and polyethylene powder, said powders being described as the "reflection-minimized powder" in the present application, and also includes titanium dioxide and sericite, which are now Markush group elements claimed in new claims 7-9 herein.

Table 2 in JP '122 shows an example of the finishing composition. The English translation of Table 2 is as follows:



Ingredient		Amount (wt.%)
A	Spherical nylon powder (mean particle size: 7 $\mu$ m)	25
	Titanium oxide	20
	Talc	30
	Mica	10
	Red oxide of iron	1
	Ultramarine	1
	Paraben	0.3
	Yellow oxide of iron	3
B	Liquid paraffin	5
	Squalane	4.8
Total		100.0

As discussed with Examiner Wells during the interview, the composition of JP '122 shown above is very similar to a composition (P Comp. Ex. 1) shown in Table 4 of the present specification on page 66 as a comparative example of the second layer finishing composition. In particular, both of these compositions contain 25 wt.% of nylon powder and 20 wt.% of titanium dioxide. There is only the slight difference that nylon powder and titanium oxide are included in the diffuse reflection powder in JP '122, whereas, in the present application, nylon powder is included in the reflection-minimized powder, and titanium oxide is included in the reflection powder.

Thus, as discussed with Examiner Wells, it is believed that the compositions are so comparable so as to support the argument of unexpected results set forth above. In particular, it is believed that comparison can be made between a comparative example of the second layer finishing composition and an example of the first layer foundation composition are used, to a case in which an

example of the second layer finishing composition and an example of the first layer foundation composition, in Table 5 in the present specification on page 69. Combinations 6 and 7 correspond to the former case and Combinations 8, 9 and 11 correspond to the latter case.

For example, when the case in which the comparative example (P Comp. Ex. (1)) in Table 4 is used as a finishing composition (Combination 6) and the case in which the example (P Ex. (2)) in Table 4 is used as a finishing composition (Combination 8) are compared, combination 8 is shown to be quite superior to combination 6 in both of concealment of irregularities and non-powdery appearance. The example (P Ex. (2)) contains 25 wt.% of nylon powder (the reflection-minimized powder) and 6 wt.% of titanium oxide powder (the reflection powder). The comparative example (P. Comp. Ex. (1)) contains 25 wt.% of nylon powder (the reflection-minimized powder), 20 wt.% of titanium oxide powder and 10 wt.% of mica (the reflection powder). In Tables 2, 4 and 6, evaluations of concealment and irregularities are described by the rating system "AA", "BB", "CC" and "DD". Descriptions of these ratings may be found on page 62, lines 5-26.

For example, as shown in combination 6 in Table 5 on 69, if the foundation composition of JP '323 is substituted for the first layer foundation composition of JP '122, a powdery appearance is imparted. Combination 6 corresponds to such a case where the foundation composition of JP '323 is substituted for the first layer foundation composition of JP '122. Combinations 8, 9 and 11 correspond to the kit of the present invention.

From comparing combination 6 and combinations 8, 9 and 11, it is clear that the kit of the present invention unexpectedly provides a very natural appearance, as well as effectively concealing skin irregularities. Combination 6 is different from combinations 8, 9 and 11 in the amount of the

reflection powder in the finishing composition. The finishing composition of combination 6 contains more than 10.0 wt.% of the reflection powder.

Moreover, the test results shown in Table 5 demonstrate that when only the first layer foundation composition of the present invention is used, concealment of irregularities in the skin is only improved slightly, and when the comparative first layer foundation composition is used, the effect of concealment of the irregularities in the skin is very poor. Furthermore, when the first layer foundation composition of the present invention and the second layer finishing composition of the comparative examples are used in combination (combinations 6 and 7), concealment of the irregularities in the skin was obtained, but a powdery, unnatural appearance was imparted to the skin.

It was unexpectedly discovered that when the first layer foundation composition of the present invention, in combination with the second layer finishing composition of the present invention was used simultaneously (combinations 8, 9 and 11), BOTH excellent concealment of the irregularities in the skin was achieved, AND a very natural skin appearance imparted to the user, *i.e.*, *a synergistic effect was obtained by use of the claimed combination of elements herein.*

If an examiner seeks to rely upon a theory of chemistry for obviousness, he must provide evidentiary support for the existence and meaning of that theory. *In re Grose et al.* 592 F2d 1161, 201 USPQ 57 (CCPA 1979). With regards to the Examiner's contention that a kit, as claimed herein, is suggested in JP '122 and JP '323, no explicit teaching or suggestion can be found for same. In view of the above cited legal authority, it is believed that the Examiner must now point to the location in the references which she is relying upon in her contention that said references suggest a kit, as claimed herein.

It is believed that, in view of the legal authorities cited above, the test results herein clearly demonstrate patentability of the presently claimed invention based on unexpected and synergistic results. Therefore, it is believed that the Examiner would now be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully rejected of Claim 6 under 35 U.S.C. 103(a) as being unpatentable over JP '122 in view of JP '323, as applied to claims 1-5 above, and further in view of Miyazawa, et al. (6,326,011).

The cited JP '122 and JP '323 references are discussed in detail above. As the Examiner has admitted, cited references JP '122 and JP '323 fail to disclose siliconated polysaccharide. To cure said deficiency, the Examiner has cited the new Miyazawa, et al. reference.

The cited secondary Miyazawa, et al. reference concerns copolymer containing reactive silyl groups, wherein a coating may be obtained which is resistant to washing, and which can modify the nature of hair, improve make-up retention, provide skin protection, impart water repellency, provide resistance to fouling, and provide sizing and crease resistance to fibers, among others. In addition, a composition containing these copolymers is taught, as well as a method of treating fibers with the composition.

The Examiner's comments with regards to the disclosure in the column 10, lines 38-Col. 12, line 31, of Miyazawa, et al. are noted. However, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In re Geiger* 815 F2d 686, 2 PQ2d 1276 (CAFC 1987); *In re Fine* 837 F2d 1071, 5 PQ2d 1596 (CAFC 1988). After a careful reading thereof, it was seen that a

siliconized polysaccharide is disclosed as a film-forming ingredient. However, it is believed that there is no disclosure or suggestion of adding the siliconized polysaccharide taught therein to the first foundation layer of JP '122 because of the expectation of the expectation of achieving a foundation with transfer-resistant properties, wherein the second layer can be applied without smearing the first layer, as is suggested by the Examiner.

Furthermore, it is believed that there is no teaching or suggestion of including said siliconized polysaccharide in a kit, as claimed herein. Rather, it is believed that such a teaching comes only from the present invention, and constitutes an important element or aspect thereof. In view of such lack of disclosure, and the lack of a specific recitation of where such teaching and/or suggestion is made in the reference, it is believed that the rejection fails as a matter of law. Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action and allowance thereof is accordingly respectfully requested. In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Donald E. Townsend", with a long, sweeping horizontal stroke at the end.

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The present kit

a first layer foundation composition

- i) a silicone oil
- ii) a polyether-modified silicone represented by the formula in claim 1
- iii) water
- iv) hydrophobic powder

a second layer finishing composition

1-100 wt.% of reflection-minimized powder

less than 10 wt.% of reflection powder

#### Relationship of reflection percentage and powder

